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PATENT  
Attorney Docket No. 98124X205843  
Client Reference No. 98124CON2

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JA  
5/26/03

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Wang et al.

Application No. 09/636,246

Art Unit: 1765

Examiner: Kin Chan Chen

Filed: August 10, 2000

For: POLISHING SYSTEM WITH  
STOPPING COMPOUND AND  
METHOD OF ITS USE

**RESPONSE TO RESTRICTION REQUIREMENT**

Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated April 18, 2003, which sets forth a restriction requirement, applicants elect, with traverse, the following polishing system/composition for the purposes of examination: (a) water as the liquid carrier, (b) a peroxide oxidizing agent (more specifically, hydrogen peroxide), (c) a carboxylic acid polishing additive (more specifically, tartaric acid), (d) a polyethylenimine stopping compound, (e) a passivation film forming agent comprising one or more 5-6 member heterocyclic nitrogen-containing rings (more specifically, benzotriazole), and (f) an abrasive suspended in the liquid carrier. Claims 1, 3, 4, 11-19, 22, 24, 26-31, 36-40, 42-44, 49, and 51 encompass the aforesaid particular polishing system/composition.

Applicants note that, if and when a generic claim embracing the elected species is allowed, the nonelected species, if included in dependent claims incorporating all of the limitations of the generic claim, will no longer be withdrawn from consideration since they also would be fully embraced by the generic claim. M.P.E.P. § 809.02(c). In any event, however, Applicants respectfully submit that the restriction requirement is improper for the reasons set forth herein and, therefore, request withdrawal of the restriction requirement.

*Summary of Examiner Interview*

Applicants thank Examiner Chen for the courtesies extended to Applicants' representative, John Kilyk, Jr., during the telephonic interview of May 12, 2003. The restriction requirement was discussed, consistent with the remarks set forth herein. Examiner Chen indicated that the restriction requirement with respect to the election of a particular liquid carrier would be withdrawn. Examiner Chen also indicated his intention to try to reduce the extent of the restriction requirement in view of his search of the art.

*Discussion of the Restriction Requirement*

The Manual of Patent Examining Procedure (M.P.E.P.) recites the requirements for a proper restriction requirement. In particular, the M.P.E.P. states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see M.P.E.P. Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see M.P.E.P. Section 806.05 - Section 806.05(i)); *and*

(B) There must be a serious burden on the examiner if restriction is required (see M.P.E.P. Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).

(M.P.E.P. § 803 (emphasis added)). These are two separate criteria that must be satisfied to support a proper restriction requirement. The fact that *both* criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.:

If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.

(M.P.E.P. § 803 (emphasis added)). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the examiner to search and examine all of the pending claims at the same time, the examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

With respect to the present application and the outstanding restriction requirement, the specific polishing systems/compositions encompassed by the pending claims are sufficiently similar that there will be no serious burden on the Examiner to search and examine all of the subject matter defined by the pending claims at the same time. For example, all of the polishing systems/compositions encompassed by the pending claims require the presence of, and are defined by, the same particular components (namely, liquid carrier, oxidizing agent,

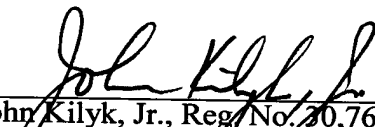
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polishing additive, and stopping compared to used with a polishing pad and/or abrasive), and the stopping compound is a cationically charged nitrogen-containing compound. This similarity of the subject matter encompassed by the pending claims, as well as other similarities not enumerated herein, illustrate that there would be no serious burden on the Examiner to search and examine all of the subject matter encompassed by the pending claims at the same time.

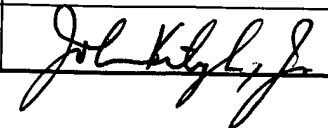
Furthermore, Applicants do not believe that there would be a serious burden on the Examiner to search and examine all of the claimed subject matter at the same time because the claimed subject matter was the subject of an earlier search conducted by Examiner Brown with respect to the present application. While Applicants agree that the subject matter encompassed by the pending claims must, and should, be fully searched, Applicants believe that the earlier search already of record demonstrates that the outstanding restriction requirement is not necessary to fully and effectively conduct a further search and continue examination as to all of the claimed subject matter (see, e.g., M.P.E.P. § 704.01).

In view of the foregoing remarks, Applicants respectfully request withdrawal of the restriction requirement, such that all of the subject matter encompassed by the pending claims is considered at the same time. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

  
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Date: May 16, 2003

<b>CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8</b>			
I hereby certify that this Response to Office Action and all accompanying documents are, on the date indicated below, <input checked="" type="checkbox"/> being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.			
Name (Print/Type)	John Kilyk, Jr.		
Signature		Date	May 16, 2003